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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,262	04/10/2006	Fumiki Murakami	0152-0730PUS1	8789
2292 7590 03/26/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER NGUYEN, HAIDUNG D				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
03/26/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Office Action Summary

**Application No.**

10/575,262

**Applicant(s)**

MURAKAMI, FUMIKI

**Examiner**

Haidung D. Nguyen

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is responsive to applicant's amendment/remarks filed 1/15/09.

Claims 1, 3-24 are currently pending.

2. The previous rejection of claim 23 under 35 U.S.C. 112, second paragraph, is withdrawn in view of applicant's amendment.

3. Claims 1, 3 - 24 were rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nakacho et al. (WO 00/09518). This rejection is withdrawn in view of applicant's amendment.

4. Claim 2 was rejected under 35 U.S.C. 103(a) as being unpatentable over Nakacho et al as applied to claim 1 above, and further in view of Harashina et al (WO03/046085). This rejection is maintained.

5. Note the following new grounds of rejection:

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**19. Claims 1, 3-24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nakacho et al. (WO00/09518).**

6. Nakacho discloses halogen-free flame retardant composition comprising (A) a compound selected from metal oxides such as iron oxide, copper oxide (column 11, lines 60-61) or trivalent phosphorous compound such as triphenyl phosphine (column 10, lines 66-67); and (B) a phosphazene compound (column 3, line 6 - column 4, line 53).

7. Nakacho further discloses a flame-retardant resin composition comprising the flame retardant above and a resin. A wide variety of resins can be used including thermoplastic resin such as polyphenylene ether, polyphenylene sulfide, polycarbonate, polyamide, and ABS; thermosetting resin such as unsaturated polyester, diallyl phthalate, urea, phenolic, and epoxy resins. The resins can be used singly or in combination. The ratio of the phosphazene compound to the resin is 0.1-100:100 weight parts (column 8, line 28 - column 9, line 14).

8. Nakacho further discloses a molded article obtainable by molding the flame retardant resin composition above.

9. Nakacho is silent on the properties of the phosphazene compound as claimed. However, the where the claimed and prior art products are identical or substantially identical in structure or composition, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

10. Nakacho discloses using metal oxides such as iron oxide in the flame retardant composition. Nakacho does not expressly disclose the amount of (A) and (B) based on the total amount of (A) and (B) as claimed. However, Nakacho discloses the amount of metal oxide relative to the resin is 0.01-50 wt. parts (column 10, lines 16-21) and the amount of the phosphazene compound relative to the resin is 0.1-100 wt. parts (column

9, lines 9-14), based on 100 wt. parts of the resin; which are overlapping the claimed amounts.

11. The reference specifically or inherently meets each of the claimed limitations.
12. The reference is anticipatory.
13. In the event that any minor modifications are necessary to meet the claimed limitations, such as selection of a specific phosphazene compound or metal oxide or minor variation in amount of each component, such modifications are well within the purview of the skilled artisan.

### ***Response to Arguments***

16. Applicant's arguments filed 1/15/09 have been fully considered but they are not persuasive.

17. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a specific phosphazene compound) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Although Nakacho et al. is silent on the properties the phosphazene compound, the Examiner is in position that the phosphazene compound disclosed in Nakacho et al. possesses the claimed properties since Nakacho et al. because disclose similar phosphazene compounds (column 3, line 1-column, line 41). Since the PTO does not have proper means to conduct experiments, the burden of

proof is shifted to applicants to show otherwise. *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1911); *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980). The applicant fails to prove that the prior art phosphazene compounds do not necessarily or inherently possess the characteristic of their claimed phosphazene compounds.

18. In response to applicant's argument that the references fail to show specific metal oxides used in the examples, it is noted that any part of the specification can support an enabling disclosure, even a background section that discusses, or even disparages, the subject matter disclosed therein. *Callicrate v. Wadsworth Mfg., Inc.*, 427 F.3d 1361, 77 USPQ2d 1041 (Fed. Cir. 2005).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haidung D. Nguyen whose telephone number is (571)270-5455. The examiner can normally be reached on M-Th: 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Kopec/  
Primary Examiner, Art Unit 1796

\HN\  
Examiner  
3/18/09